REMARKS/ARGUMENTS

In response to the Office Action dated July 15, 2004, claim 7 is amended. Claims 1-12 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

Claims 1-12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Takemoto et al. (USPN 6,665,452). The Examiner asserts that "Takemoto either explicitly or inherently discloses all of the claimed circuitry which is evidenced by the fact that Takemoto discloses an image data correction conversion circuit and a skew quantity correction method. Predetermined lines of image data are stored and the quantity of skew of the store image data is measured (note col 3, lines 58-col 4, line 59)."

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. ***Helifix Ltd. v. Blok-Lok, Ltd.***, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); ***Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.,*** 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Applicant submits that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 102 for lack of novelty, and that the Examiner's reliance upon the doctrine of inherency is misplaced.

In order to rely upon the doctrine of inherency, the Examiner is required to identify a factual basis upon which to predicate the determination that an allegedly inherent feature would **necessarily** flow from the teachings of the applied prior art. ***Finnegan Corp. v. ITC***, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); ***In re Robertson***, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). As articulated by the Honorable Board of Patent Appeals and Interferences in ***ex parte Schricker***, 56 USPQ2d 1723, 1725 (BPAI 2000):

> However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. ***Compare In re Rijckaert***, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art) ***In re Yates***, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of pointing to the page and line of Takemoto et al. which justifies his inherency theory. Specifically, independent claim 1 requires, *inter alia*:

> first skew correcting means which correct image data on a line basis in a sub-scanning direction based on the amount of relative inclination between the print heads; and
>
> second skew correcting means which ***correct the image data corrected by the first correcting means*** on a unit basis smaller than one line.

Independent claim 11 requires, *inter alia*:

> first skew correcting means which correct image data on a line basis; and
>
> second skew correcting means which ***correct the image data corrected by the first correcting means*** on a unit basis smaller than one line.

At best, Takemoto et al. discloses merely a first skew correcting means that corrects image data in a sub-scanning direction based on the amount of relative inclination (skew). There is not second skew correcting means that corrects the image data corrected by the first correcting means on a unit basis smaller than one line. In this regard, Takemoto et al. describes memory

110 of controller 11 as storing image data from a host. This image data is then processed according to an instruction from the host using line buffer 10 to read out the image data from memory 110. The description at column 5, line 26 through column 8, line 11 explains how skew is then corrected. However, it is clear from this description that there is no second skew correcting means which correct the image data corrected by the first correcting means on a unit basis smaller than one line.

Simply put, while column 3, line 58-column 4, line 59 does describe CPU 8 measuring the quantity and direction of skew from the output of sensors 80a and 80b and operates into how many blocks image data stored in line buffer 10 is divided, such description does not reasonably justify invoking an inherency theory since there is no second skew correcting means described at column 3, line 58-column 4, line 59. Moreover, the remaining description of Takemoto et al. further establishes that but a single skew correcting means is disclosed, which undermines the Examiner's inherency theory.

Thus, independent claims 1 and 11, as well as dependent claims 2-4 and 12, are patentable over Takemoto et al.

Independent claim 5 requires, *inter alia*:

> a bit map memory;
> a read address generator which sequentially generates read addresses from a leading address in the image data region of the bitmap memory;
> a write address generator for generating, from the read addresses, write addresses by correcting relative inclination between the print heads on a line basis; and
> a memory controller which writes image data to an image data region of the bitmap memory, wherein ***the leading and rear end portions of the image data region provide respective blank regions***, reads from the read addresses generated by the read address generator, image data stored in the image region and writes the image data at the write addresses generated by the write address generator.

At best, the bitmap memory would correspond to the memory 110 of Takemoto et al. However, correction of relative inclination is carried out in Takemoto et al. after image data is stored in line buffer 10. That is, there is no correction of relative inclination between reading out image data from memory 110 and storing in line buffer 10. Consequently, Takemoto et al. does not disclose a memory controller which writes image data to an image data region of memory 110 with such an image data region of memory 110 having blank regions in the leading and rear end portions thereof, (a memory controller that) reads image date stored in the image region of memory 110 using the read addresses generated by the read address generator (i.e., addresses that are sequentially generated from a leading address in the image data region of memory 110) and (a memory controller that) writes the image data at the write addresses (of memory 110) generated by the write address generator (i.e., addresses generated from the read addresses by correcting relative inclination between the print heads on a line basis). Thus, independent claim 5, as well as dependent claim 6, are patentable over Takemoto et al.

Independent claims 7 and 8 are patentable over Takemoto et al. for similar reasons, as are dependent claims 9 and 10. More specifically, Takemoto et al. does not disclose reading image data from memory 110 at the generated read addresses. In addition, Takemoto et al. has no description regarding a burst read access.

At any rate, independent claim 7 is amended to clearly delineate that "a read address generating unit for generating read addresses for image data in said bitmap memory based on correction data on relative inclination between the print heads."

The above argued differences between the claimed device vis-à-vis the device of Takemoto et al. undermine any factual determination that Takemoto et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. ***Minnesota Mining &***

Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); ***Kloster Speedsteel AB v. Crucible Inc.,*** 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Moreover, the Examiner has not established the requisite basis upon which to invoke the doctrine of inherency which requires certainty. In addition, there is a sufficient basis in the reference to Takemoto et al. itself to undermine the inherency theory. Applicant, therefore, submits that the imposed rejection of claims 1-12 under 35 U.S.C. § 102 for lack of novelty as evidenced by Takemoto et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

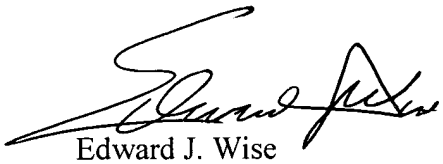
CONCLUSION

Accordingly, it is urged that the application, as amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, NW
Washington, DC 20005-3096
(202) 756-8000 EJW/dmd
DATE: October 14, 2004
Facsimile: (202) 756-8087